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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,556	12/04/2003	Satoshi Kashiwabara	245920US0CONT	5484

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1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SAVAGE, JASON L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,556

Applicant(s)

KASHIWABARA ET AL.

Examiner

Jason L. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS filed 2-2-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12042003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP'540 (JP 2001-54540).

JP'540 teaches a coating liquid that forms a transparent conductive film when applied to a substrate (International preliminary Examination Report for PCT/JP02/05343, Section V). JP'540 further teaches the liquid coating contain fine particles of ruthenium wherein a noble metals such as Ag or Au is supported on Ruthenium (Prelim Exam Report and Example S-7 in column 15 of reference).

Regarding claim 3, JP'540 teaches that a reducing agent is also added to the coating liquid composition (Prelim Exam Report).

Regarding claims 4-7, JP'450 teaches the coating composition is applied to a substrate such as a display panel and that a silicon alkoxide may be applied to the transparent film as an overlay (Prelim Exam Report).

Regarding claim 8, although JP'450 is silent to the conductive film having the claimed transmittance ratio, since the article of JP'450 comprises the same metal

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particles claimed by Applicant and is formed from a similar coating composition, one would reasonably expect the transmittance ratio of the article of JP'450 to be the same as the ratio claimed by Applicant.

Regarding claims 9-11, JP'450 teaches that the transparent film material is disposed on a display panel such as a cathode ray tube (Prelim Exam Report).

Claims 1 and 3-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Oka et al. (US 6,451,433).

Oka teaches a coating liquid that forms a transparent conductive film when applied to a substrate (abs). Oka further teaches the liquid coating contain fine particles of ruthenium and another noble metal such as Ag (col. 17, sample 31).

Regarding claim 3, Oka teaches that a reducing agent is also added to the coating liquid composition (col. 7, ln. 55-65).

Regarding claims 4-7, Oka teaches the coating composition is applied to a substrate such as a CRT of a TV and/or computer display panel and that a silicon alkoxide may be applied to the transparent film as an overlay (col. 1, ln. 28-40 and col. 11, ln. 33-55).

Regarding claim 8, although Oka is silent to the conductive film having the claimed transmittance ratio, since the article of Oka comprises the same metal particles claimed by Applicant and is formed from a similar coating composition, one would reasonably expect the transmittance ratio of the article of Oka to be the same as the ratio claimed by Applicant.

Regarding claims 9-11, Oka teaches that the transparent film material is disposed on a display panel such as a Braun tube which is equivalent to a cathode ray tube (col. 1, ln .28-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al. (US 6,451,433).

Oka does not exemplify an embodiment wherein ruthenium and one of the claimed noble metals are used to form the transparent film. However, it does teach that one may select two or more metals selected from the group of ruthenium and all of the noble metals claimed by Applicant (col. 11, ln. 3-11). Oka further teaches that ruthenium may be used in combination with a noble metal such as silver (col. 17, sample 31). It would have been obvious to one of ordinary skill in the art to have formed the composition comprising two noble metals including ruthenium and any other noble metal such as gold, platinum, palladium, rhodium and osmium since Oka teaches that such a combination is suitable for use in the film forming composition.

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Any inquiry to this communication or earlier communications from the Examiner should be directed to Jason Savage, whose telephone number is (571)272-1542. The Examiner can normally be reached Monday to Friday from 6:30 AM to 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (571)272-1535.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Savage

9-1-04


DEBORAH JONES

SUPERVISORY PATENT EXAMINER